

U.S. Patent Application No. 10/664,833  
P24138.A03 (S 1010/US)**REMARKS****Status of the Claims**

Upon entry of the amendment above, claims 1-28 will be pending, claims 1 and 14 being independent.

**Summary of the Office Action**

Applicants' amendment of July 27, 2005 is objected to under 35 USC §132 for allegedly introducing new matter in the specification in paragraphs 0056 and 0067.

Claims 1, 3-5, 9-12, 14-17, 20, and 22 are rejected under 35 USC §102(b) as being anticipated by WO 98/37782 (hereinafter "WO '782").

Claims 6-8, 13, and 23 are rejected under 35 USC §103(a) as being unpatentable over WO '782.

Claims 6-8, and 17-19 are rejected under 35 USC §103(a) as being unpatentable over WO '782 in view of BARRET (U.S. Patent No. 5,940,990).

Claim 2 is rejected under 35 USC §103(a) as being unpatentable over WO '782 in view of MACCANO (U.S. Patent No. 4,822,500).

Claim 21 is rejected under 35 USC §103(a) as being unpatentable over WO '782 in view of BASSO (U.S. Patent No. 6,405,457).

**Response to the Office Action****A. Request for Withdrawal of Finality of Office Action**

In a separate paper being filed concurrently herewith, Applicants request that the finality of the Office action to which they here reply be withdrawn as being premature.

**B. Summary of Amendment**

Applicants have amended independent claim 1 by specifying that the mechanism for tightening the inner envelope does not include any keeper affixed to the outer envelope forward of a forwardmost one of the rear keeper (which rear keeper is specified as being affixed to the outer envelope). By contrast, in WO '782 all of the keepers 18 affixed to the outer envelope are part of the mechanism for tightening the inner envelope.

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In addition, Applicants have amended dependent claims 8 and 19 to specify that the strands of the V-shaped portion of the rear keeper are affixed to the outer envelope at spaced locations. This feature is not taught or suggested by WO '782 or other references relied upon in the Office action.

Further, Applicants have amended independent claim 14 by specifying that, unlike WO '782, the mechanism for tightening the outer envelope comprises a second lace. In WO '782, a single lace extends alternately through keepers of an inner envelope and keepers of an outer envelope.

Still further, in claim 21, which depends from independent claim 14, Applicants have specified that the rear keeper of the inner envelope tightening mechanism, which keeper is fixed to the outer envelope, is located between a first plurality of keepers on the lower portion of the inner envelope and a second plurality of keepers on the upper portion of the inner envelope. WO '782 fails to teach or suggest this feature, as does any reasonable combination of references.

Finally, new dependent claims 24-28 have been added.

New claims 24 and 27 depend from independent claims 1 and 14, respectively, and specify that the rear keeper comprises a strap affixed against an inner surface of the outer envelope.

New claim 25 depends from claim 1 and adds a limitation requiring a second lace as part of the mechanism for tightening the outer envelope, i.e., similar to the aforementioned limitation appearing in independent claim 14.

New claim 26 depends from claim 1 and adds the limitation of the lace of the inner envelope tightening mechanism extending successively through keepers of a first plurality of keepers of the inner envelope, through the rear keeper (which is affixed to the outer envelope), and through keepers of a second plurality of keepers of the inner envelope. This subject matter is similar to that of claim 21, mentioned above.

Claim 28 depends from claim 14 and adds a limitation that appears in claim 1, as amended, i.e., that the mechanism for tightening the inner envelope does not include any keeper affixed to the outer envelope forward of a forwardmost one of the rear keeper of the inner envelope tightening mechanism.

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P24138.A03 (S 1010/US)**C. Withdrawal of Objection Under 35 USC §132**

At the top of page 2 of the Office action, amendments that Applicants had made to paragraphs 0056 and 0067 of the specification are objected to as allegedly having introduced "new matter" into the disclosure of the instant application.

Although the assertion "[t]here was no support for this in the application as originally filed" is offered, no analysis is provided.

Applicants submit that no prohibited new matter has been added by means of the amendments to paragraphs 0056 and 0067 of the specification and, therefore, they request that the objection be withdrawn.

The amendments made to paragraphs 0056 and 0067 included the statement that "... the rear keeper is affixed to an inner surface of the outer envelope 12" and "... the rear keeper is affixed to an inner surface of the outer envelope 90", respectively.

Applicants' request that the objection be withdrawn is based at least upon the following, reference being had to the original disclosure.

Figs. 1, 3, 4, and 5, taken with paragraph 0057, provide sufficient support. In paragraph 0057 of the specification, Applicants explain that stitching 64, 65 affix the strands 61, 62 of the keeper 60 to the outer envelope 12. The cross-sectional view of Fig. 3 clearly shows the stitching 64 and the keeper 60 affixed to an inner surface of the envelope 12. Similarly, the cross-sectional view of Fig. 5 clearly shows the stitching (not labeled) and the keeper 104 affixed to an inner surface of the envelope 90.

**D. Withdrawal of Rejections Under 35 USC §§102, 103 Based Upon WO '782**

At least for the following reasons, Applicants request that the rejections based upon WO '782, alone or in combination with other documents, and whether for anticipation or obviousness, be withdrawn.

In the boot of WO '782, the rearmost keeper 18 is not affixed to the outer envelope of the boot substantially in an area of the heel. Instead, it is positioned in

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the area of the flexion crease of the boot, i.e., at the junction between the lower leg portion and the forefoot portion of the boot. In fact, the lace 20 of the boot of WO '782 is guided within a lacing zone that extends between the metatarsus and the instep, alternately through keepers 18, 22 on opposite sides of the opening 16 of the shell 12. See, e.g., page 5, lines 4-12.

Although Applicants respectfully submit that claims 1 and 14 should be found allowable without amendment, they have introduced amendments to claims 1 and 14 in an attempt to advance prosecution of the instant application to allowance.

In claim 1, Applicants have now specified that the mechanism for tightening the inner envelope of the upper does not include any keeper affixed to the outer envelope forward of a forwardmost one of said at least one rear keeper affixed to the outer envelope. By contrast, in WO '782 the mechanism for tightening the inner envelope includes several keepers fixed to the outer envelope, including forwardmost ones located in the area of the toes.

In claim 14, Applicants have now specified that the mechanism for tightening the outer envelope of the upper includes a second lace. By contrast, the boot of WO '782 includes only a single lace, which tightens both the shell and the liner (i.e., inner and outer envelopes)

At least for the reasons given above with regard to claims 1 and 14, Applicants request that the rejections based upon WO '782, whether taken alone or in combination with an additional document, be withdrawn.

In addition to the foregoing, which refers to independent claims 1 and 14, Applicants direct attention to claims 8 and 19, which refer to the rear keeper being a folded strap portion that is V-shaped. Page 9 of the Office action (under the heading "Response to Arguments") includes a statement that "WO '782 clearly shows a loop 22 shown as a V-shape (the legs of the loop and the portion connecting the legs together)."

Applicants do not agree. If this argument and rejection are to be maintained,

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Applicants kindly request a fuller explanation, perhaps supplemented with an annotated copy of any relevant part of the drawings of WO '782.

If the legs of a strap 22 of WO '782 being connected together would seem to form more of a teardrop shape. A "V," Applicants submit, include legs that diverge upwardly from the bottom. In contrast, the loop portion through which the lace 20 extends in WO '782, which would form the bottom of the alleged "V" shape are spaced apart (i.e., to form a passage for the lace) and then they converge as the strands of the strap 22 are laid one upon the other.

Also under the heading "Response to Arguments" is the statement that "[p]art of the heel [of the boot of WO '782] is located in the area where the rearmost keeper is located and therefore, this limitation is met by WO '782." Applicants disagree with the analysis.

In claim 14 and, by amendment above, in claim 1, Applicants refer to the rear keeper as being affixed, not merely located substantially in the area of the heel. As mentioned above, the rearmost keeper of the boot of WO '782 is located proximate the flexion crease of the boot, not substantially in the area of the heel.

#### **SUMMARY AND CONCLUSION**

Entry of the amendment presented in this reply is kindly requested. By means of the amendment and at least for the reasons presented above, reconsideration and allowance are requested.

Fees for payment of claims and for an extension of time can be charged to Deposit Account No. 19-0089. Further, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

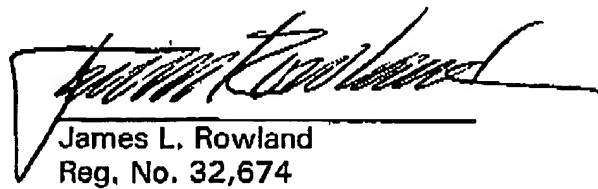
Further, although an extension of time for a single month is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) to render this reply

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timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
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